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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/524,205	03/13/2000	Gilbert Allan Segal	POPT-0002	7194

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EXAMINER	
BASHORE, ALAIN L	
ART UNIT	**PAPER NUMBER**
1762	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/524,205	SEGAL ET AL.	
	Examiner	Art Unit	
	Alain L. Bashore	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-42 and 44-90* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-42 and 44-90* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 58 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Because the term "system" may be defined as solely method, and the term "server system" may be entirely software, the claims may be interpreted as claiming software per se, which is non-statutory.

A computer program (i.e. software) must be claimed as a computer-readable medium encoded with a data structure. There must be positively recited in the body of the claim at least one recitation defining structural and functional interrelationships between the data structure and the computer software and hardware components (a useful, concrete and tangible result produced). This permits the data structure's functionality to be realized, as more than a manipulation of an abstract idea [*In re Wamerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994)].

Claim Rejections - 35 USC § 102 / 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 21- 26, 28, 33-42, 44-50, 52, 57-70, 72-90 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kolton et al.

Kolton et al appears to disclose a method and system of identifying financial instruments meeting user-defined investment criteria further wherein financial instrument data is retrieved from a data source (col 2, lines 25-38). There is identified values for a plurality of searchable parameters for particular financial instruments in the data (col 5, lines 8-44), and user-defined search criteria which is compared to the values identified for the search parameters for the particular financial instruments and

then the least one financial instrument is identified and transmitted for display (col 12, lines 1-36; fig 4a-c).

There is also to Kolton et al disclosed stocks, stock options, bonds (col 8, lines 38-39; col 2, lines 17-18). A plurality of searchable parameters (including price , stock symbol) disclosed at different user-defined values (col 21, lines 15-2649).The use of the Internet with web browser is utilized as is a database to store parameters.

Regarding receiving modified user-defined search criteria which is then compared to identify and transmit at least one financial instrument matching the user-defined search criteria, this is considered disclosed in figure 19 and col 12, lines 37-48.

As an alternative interpretation of the reference, where the term "modified user-defined" is not explicitly disclosed, it would have been obvious to one with ordinary skill in the art to include such, because Kolton et al teaches repeating searches for different criteria (col 12, lines 37-48).

6. Claims 27 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolton et al as applied to claims in the alternative 35 U.S.C 103 rejection above, and further in view of Daughtery, III.

Kolton et al does not appear to disclose at least one of the recited financial instrument data of claims 27 and 51.

Daughtery, III discloses Black-Scholes values for options (para 0028).

It would have been obvious to one with ordinary skill in the art to include Black-Scholes values as a financial instrument data because Daughtery, III teaches the value as important consideration for options (para 0028), and the primary reference teaches options as one type of commodity of interest (col 8, lines 39-40).

7. Claims 29-31, 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolton et al as applied to claims in the alternative 35 U.S.C 103 rejection above, and further in view of Walker et al.

Kolton et al does not appear to disclose confirming that a user is authorized.

Walker et al discloses confirming that a user is authorized and registered (col 17, lines 1-12) including conditions that the user has paid (col 6, lines 5-12).

It would have been obvious to one with ordinary skill in the art to including confirming that a user is authorized and registered for the purpose of security.

It would have been obvious to one with ordinary skill in the art to including that the user has paid (prior to executing a search) for the purpose of business economics.

8. Claims 32, 56, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolton et al as applied to claims in the alternative 35 U.S.C 103 rejection above, and further in view of Clark et al.

Kolton et al does not disclose the establishing of user account which is related stored criteria.

Clark et al discloses user accounts related to a financial service system (col 7, lines 49-55).

It would have been obvious to one with ordinary skill in the art to include establishing of user account which is related stored criteria because Clark et al teaches users of financial services have accounts and messages in financial communications require relationship to the account (col 7, lines 49-55).

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 21-28, 33-42, 44-52, 57-90 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 10-12, 14-15, 27-28 of copending Application No. 09/676,374. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are within the scope of the art as well known.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 21-28, 33-42, 44-52, 57-90 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-10 of copending Application No. 10/607,418. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are within the scope of the art as well known.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 21-42, 44-90 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No.6,049,783. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are within the scope of the art as well known.

Election/Restrictions

13. The restriction requirement of the previous office action (5-12-04) is hereby withdrawn.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 571-272-6739. The examiner can normally be reached on about 7:30 am to 5:00 pm (Mon. thru Thurs.).

Regarding all Class 705 applications, the management contact regarding examination is: Vincent Millin (SPE, art unit 3624) at 571-272-6747.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alain L. Bashore
Primary Examiner
Art Unit 1762